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*In re* Patent Application of:

Docket No.: 07580009US

Frederick MAY, *et al.*

Serial No.: 10/753,462

Group Art Unit: 3612

Confirmation No.: 6422

Filed: January 9, 2004

Examiner: PATEL, Kiran B.

For: **MOLDING FOR A GLASS PANE**

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### **RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

In response to the Restriction Requirement of November 10, 2004, Applicants provisionally elect Group II, claims 6-12, with traverse for the reasons discussed herein. Applicants further provisionally withdraw non-elected claims 1-5.

If extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefore are hereby authorized to be charged to **Deposit Account No. 23-1951** (McguireWoods). Please charge any deficiencies in fees and credit any overpayment of fees to the same Deposit Account.

### **REMARKS**

Applicants traverse the restriction requirement because the entire premise of the restriction is wrong and the requirement is improper. First, the invention of claims 1-5 and the invention of claims 6-12 are not related as "combination and subcombination," as alleged in the Office Action, and are not independent or distinct. MPEP § 806.04 explains that "a combination is an organization of which a subcombination or element is a part." Claim 1 recites a "molding for a window, comprising: ... a window contact member ..." Claim 6 recites "a molding for a

windshield, comprising: ... a windshield contact member ...” The examiner argues that claim 6 (Group II) is a subcombination of claim 1 (Group I). This is incorrect because the windshield molding of claim 6 is not an element of the window molding of claim 1. Additionally, a windshield is not an element of a window. Instead, a windshield and a window are glass panes that have different intended uses. One is not an element of the other. The same reasoning applies to a windshield contact member and a window contact member.

Secondly, even if Group I and Group II were related as combination and subcombination, the inventions of each group would not be distinct as suggested by the examiner. MPEP § 806.05 explains that inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. The examiner’s premises (1) that the combination of Group I (window molding) does not require the particulars of the subcombination of Group II (windshield molding), and (2) that the subcombination has utility in other combinations such as a windshield are incorrect. The structure of the invention (e.g., a molding for a glass pane) is the same, whether the glass pane is a window or a windshield. Thus, the window molding and the window contact member of claim 1 require the same structure as the windshield molding and the windshield contact member of claim 6. Indeed, the only significant difference between the independent claims is intended use. This, however, is not sufficient to render the inventions independent or distinct.

Lastly, even if the inventions were independent or distinct, it is respectfully submitted that search and examination of the entire application can be made without serious burden. There are a relatively small number of claims, and each of claims 1-15 is classified within a single class (e.g., class 296). Thus, the entire application should be examined on the merits. This premise is supported by MPEP § 803.1, which states:

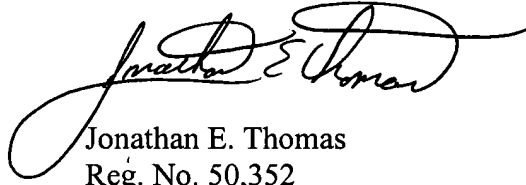
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

For these reasons, withdrawal of the restriction requirement is respectfully requested.

### CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the restriction requirement in the outstanding office action, and examination on the merits for the entire application, including claims 1-15.

Respectfully submitted,



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